

REMARKS

The Office Action mailed April 20, 2009, has been received and reviewed. Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected. Applicant has amended claims 1, 22, 25, 27 and 28, and respectfully requests reconsideration of the application as presented herein. No new matter has been added.

Claim Rejections under 35 U.S.C. § 103

Claims 1-28 were rejected as being unpatentable over U.S. Pat. Pub. No. 2003/0017833 to Forrester (“Forrester”) in view of U.S. Patent 6,985,712 to Yamakawa *et al.* (“Yamakawa”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-28 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-21 depending therefrom, independent claim 22 and claims 23 and 24 depending therefrom, independent claim 25 and claim 26 depending therefrom, and independent claims 27 and 28, Applicant’s independent claims include claim limitations not taught or suggested in the cited references.

The Office Action in the Response to Arguments section alleges:

The applicant argued that Forrester's system "never transmits and receives the same band over different antenna" (See Remark filed 03/05/2009). The examiner respectfully disagrees with the applicant's argument. As recited in independent claims, the first antenna is for transmission (i.e. transmitting the second TDMA frequency band) while the second antenna is for reception (i.e. receiving second TDMA frequency band). For such scenario, the modified Forrester's system is capable of **transceiving** the dual-band TDMA (first and second TDMA frequency bands) using the first antenna and **receiving** the dual-band TDMA using the second antenna (See above rejection for details); therefore, the modified Forrester's system does still read on the claimed limitations (based on the claimed language) since the applicant has never claimed the first antenna "for only transmitting the second TDMA frequency band" as well as the second antenna "for only receiving the second TDMA frequency band". (Office Action, p. 6; emphasis added).

Applicant has amended independent claims 1, 22, 25, 27 and 28 to more particularly point out that such limitations are, in fact, present in Applicant's claimed invention. Specifically, Applicant's amended independent claims 1, 22, 25, 27 and 28 each recite, in part, "transmitting a second TDMA frequency band using [a] first antenna" and "receiving the second TDMA frequency band using [a] second antenna" "and *the second TDMA frequency band is transmitted and received on different ones of the first and second antennas.*" Clearly Applicant's claim elements do recite "*the second TDMA frequency band is transmitted and received on different ones of the first and second antennas.*"

Furthermore, Applicant's representative, Kevin K. Johanson (Reg. No. 38,506) on July 17, 2009 held a **telephone conference with the Examiner** to discuss the proposed claim language and forwarded via email the specific proposed claim amendments to overcome the Examiner's concerns. Upon review of the proposed claim amendments, the Examiner contacted Applicant's representative to concur that such **proposed claim amendments overcome the asserted prior art teachings** of transmission and reception of dual-band TDMA over a first antenna and reception of the dual-bands over a second antenna. Accordingly, Applicant's claim amendments to independent claims 1, 22, 25, 27 and 28 recite the proposed and agreed to claim elements.

Therefore, since neither Forrester nor Yamakawa teach or suggest Applicant's claimed invention, these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent

claims 1, 22, 25, 27 and 28. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 22, 25, 27 and 28 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-21 which depend therefrom.

The nonobviousness of independent claim 22 precludes a rejection of claims 23 and 24 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 22 and claims 23 and 24 which depend therefrom.

The nonobviousness of independent claim 25 precludes a rejection of claim 26 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 25 and claim 26 which depends therefrom.

CONCLUSION

Claims 1-28 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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